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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,339	01/23/2004	Sergey N. Razumov	59036-039	4969

7590 06/19/2009
McDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

ALMATRAHI, FARIS S

ART UNIT	PAPER NUMBER
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3627

MAIL DATE	DELIVERY MODE
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06/19/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/762,339	Applicant(s) RAZUMOV, SERGEY N.	
	Examiner FARIS ALMATRAHI	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 16-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. This action is in reply to applicant amendment filed March 9, 2009.
2. Claims 2 and 14 have been amended.
3. Claim 16 has been withdrawn.
4. Claims 1-38 are pending in this application.

Claim Objections

5. Claims 17-38 are objected to because of the following informalities: Claims 17-38 have improper claim identifier. Claims 17-38 are directed to a non-elected invention and are improperly labeled as (original). Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claim 1** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3627

8. **Claim 1** recites the limitation "a server configured for receiving the request and enabling the purchaser to locate a retail network node at which the requested item is available, the node being provided outside a local retail network corresponding to the point of sale selected for delivery, a path being arranged for routing the item from the node to the selected point of sale". The limitation as phrased is viewed to be vague and indefinite because it is unclear what the applicant is referring to. It is unclear what the applicant is implying as being delivered. Also, it is unclear what the phrase "a path being arranged for routing the item from the node to the selected point of sale" is implying or limiting. Applicant is requested to construct claims eliminating ambiguity and clarifying what he is referring to.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1-15** are rejected under 35 U.S.C. 102(b) as being anticipated by Perkowski (US Publication No. 2003/0009392 A1).

11. Perkowski shows a system for processing orders supported by multiple retail networks and comprising a client terminal for sending a request providing indication of an item being purchased and indication of a point of sale selected for delivery of the

Art Unit: 3627

item, together with an identifier of a purchaser (Abstract), the system comprising: a server configured for receiving the request and enabling the purchaser to locate a retail network node at which the requested item is available, the node being provided outside a local retail network corresponding to the point of sale selected for delivery, a path being arranged for routing the item from the node to the selected point of sale (Abstract, Figure 2, Paragraphs [0107], [0232], [0416], [1002]). A second server configured for arranging a return path for return of an item returned by a customer from a point of sales selected by the customer for return to a selected node (Figure 2, Paragraphs [0107], [0232]). A two-directional transfer of goods between regional node and selected node (Figure 2).

Response to Arguments

12. Applicant's arguments filed on March 9, 2009 have been fully considered but they are not persuasive.

13. Regarding Applicants arguments that 35 U.S.C. 112 second paragraph is improper for claims 1-15. In light of applicant's amendment and discussion, 112 second paragraph for claims 2-15 has been withdrawn. Rejection of Claim 1 under 112 second paragraph is still viewed to be proper. The limitation "the node being provided outside a local retail network corresponding to the point of sale selected for delivery, a path being arranged for routing the item from the node to the selected point of sale" as currently recited is still viewed to be vague. The phrase "a path being arranged for routing the

Art Unit: 3627

item from the node to the selected point of sale” renders the limitation vague because it is unclear how this feature ties into the limitation.

14. In light of applicant’s choice to pursue system claims, Applicant is reminded that claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd Pat. App. & Inter. 1987). Thus, the structural limitations of claims 1-15 are disclosed by Perkowski as described above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3627

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faris Almatrahi whose telephone number is (571)270-3326. The examiner can normally be reached on Monday to Friday 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Faris Almatrahi
Examiner
Art Unit 3627

FA
/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627

Application/Control Number: 10/762,339
Art Unit: 3627

Page 7